REMARKS

Claims 1-10 and 12-32 are pending in the application. No claims have been added, cancelled, or amended. Claims 1-10 and 12-32 accordingly remain pending in the application.

35 U.S.C. § 103(a) Rejections

Claims 1-5, 13, 20, 28, and 29-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0066084 (hereinafter "Kaars") in view of newly cited U.S. Patent No. 6,040,829 (hereinafter "Croy"). Claims 6, 7, 14, 15, 16, 21, 22, 23, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars in view of Croy in further view of U.S. Patent No. 6,449,767 (hereinafter "Krapf"). Claims 8, 17, 22, and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy in further view of U.S. Publication No. 2003/0110513 (hereinafter "Plourde"). Claims 9, 10, 18, 19, and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy in further view of U.S. Publication No. 2002/0104019 (hereinafter "Chatani"). Claims 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars and Croy in further view of U.S. Patent No. 6,532,593 (hereinafter "Moroney"). Applicant respectfully traverses these rejections and requests reconsideration in view of the following comments.

Applicant appreciates the Examiner's withdrawal of 102(e) rejections under Kaars and agreement that the previous arguments regarding these rejections are persuasive. Applicant notes the new grounds for rejection. However, Applicant believes the claims recite features neither taught nor suggested by the newly cited art. For example, claim 1 recites a transcode subsystem that is configured, in relevant part, to

> "detect a communication from the secondary device;
> determine a target data format corresponding to the secondary device;
> convey a request to an external entity for a transcode subunit

> corresponding to said target data format, in response to determining the transcode subsystem is not configured to support said target data format; …"

In the present Office Action, the Examiner contends Kaars discloses these features at paragraphs 28 and 35 except that Kaars does not disclose a system to detect a communication from the secondary device. The Examiner suggests Croy teaches a system to detect a communication from the secondary device at column 4, lines 10-37 and that

> "At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the two-way remote control device taught by Croy to replace the one-way remote control system disclosed by Kaars."

It is unclear exactly what is meant by a one-way remote control system disclosed by Kaars. Kaars discloses a user interface, but does not specifically describe it as including a remote control or as being a one-way system. In addition, Kaars discloses diverse output devices that are coupled to the transcoding system through a one-way interface. It is noted Kaars does not explicitly include a remote control among these output devices. If, for the sake of argument, it is assumed that the Examiner is suggesting replacing these devices with the two-way remote control device taught by Croy, Applicant submits the proposed combination does not produce the invention as claimed. Croy refers to the remote interface device as a personal navigator (PN). Croy specifies a variety of interface technologies, including two-way IR, RF, RS232, Ethernet, etc. for communicating with the PN. However, Croy does not describe data formats that are compatible or incompatible with the PN. Instead, Croy teaches that a base station decodes data from, for example, the vertical blanking interval of a video channel and provides that information directly to the PN, without format conversion. It is therefore apparent that the PN uses a standard format that is set by the base station. If Croy's PN were used to replace other devices in Kaars, it would still use the same format. Moreover, any secondary device that incorporated the teachings of Croy would necessarily use the same format. Accordingly, if Cory's two-way PN were added to the system of Kaars, the result would be a system absent any need for transcoding. Therefore the combined system would not "determine a target data format corresponding to the secondary device; convey a request to an external entity for a transcode subunit

corresponding to said target data format, in response to determining the transcode subsystem is not configured to support said target data format," as is recited in claim 1. These features would not be needed as the secondary device format would be pre-determined. For at least these reasons, Applicant submits claim 1 is patentably distinct from the cited art. As independent claims 13 and 20 include features similar to those of claim 1, claims 13 and 20 are believed patentable distinct for similar reasons. As each of the dependent claims includes at least the features of the independent claim upon which it depends, each of the dependent claims is believed patentable as well.

In addition, Applicant submits there is no motivation to combine Croy with Kaars. The Examiner suggests "The motivation would have been to enable all of the diverse devices disclosed by Kaars (figure 1, parts 120, 132, 134, 142, and 150) to be able to control the transcoding unit regardless of the network they are connected to." However, Kaars is generally directed to transcoding to resolve incompatibility with a variety of devices and their specific data formats. Furthermore, Kaars teaches

> "With the onset of the consumer electronics (CE) explosion, comes the problems of compatibility. No manufacturer or retailer desires to place a product on the market just to find that the data format it was designed for is not compatible with the current technology, or to find that it cannot interact with other devices and systems on the market. For example, a device as the Wireless Internet Appliance (WIA, e.g., a WebPad) may support a MPEG4 data format but not MPEG2. "MPEG4" and "MPEG2" refer to two widely used data formats that are well known in the art. Note that within a data format such as based on MPEG2 many data formats exist depending on, e.g., different resolutions and compression ratios etc. As another example, a personal digital assistant (PDA) may only support a transfer and playback bitrate much smaller than that of the received data. If the data is not transcoded, it cannot be stored in and played-back from the PDA. Even current cellular telephone technology is incorporating various data playback features into the mobile telephone. But, since the bitrate of data reception of the cellular telephone is limited, it may be necessary that the data must first be transcoded (transcoding typically, but not exclusively, comprises the steps of: a possible partial or complete decoding of an encoded content followed by a re-encoding) into a compatible format for proper transmission to the mobile phone.
>
> The present invention solves this compatibility problem in a two-step

process. First, a storage device receives data in a first format. Second, in an off-line mode, the stored data is transcoded into a desired format. As an example the transcoding can be to a format compatible with the next use of the consumer, whereby the transcoded data is stored in the storage device. Transcoding can be used to take the data from a higher to a lower resolution or with a higher compression ratio (with typically some quality loss). The compatibility transcoding can, e.g., also include a transcoding that includes an image enhancement in order to better match a higher display quality (this may also apply to a sound enhancement in order to better match a higher speaker quality etc.). The consumer may have the ability of interfacing with the system to input information about the output device or network that requires compatibility transcoding. By handling the transcoding in an off-line mode, the system can devote as many resources to the transcoding process as are available, independent of the duration of the signal in real-time. Hence the production of more affordable and interchangeable devices is enabled." (Kaars, [0021]-[0022], emphasis added).

As may be seen from the above, in order to enable production of more affordable and interchangeable devices Kaars teaches away from introducing a product on the market that is designed for a specific data format on both ends of a communications link. The PN as disclosed by Croy is such a product because it uses a pre-determined format between the PN and the base station. Further, in order to enable all of the diverse devices disclosed by Kaars using the teachings of Croy, the pre-determined format would have to be built into each of Kaars's diverse devices, adding cost and risking future incompatibility. Therefore, one of ordinary skill in the art would not be motivated to use the PN of Croy in the system of Kaars, as suggested. For at least these additional reasons, Applicant submits claim 1 is patentably distinct from the cited art. As independent claims 13 and 20 include features similar to those of claim 1, claims 13 and 20 are believed patentable distinct for similar reasons.

Also, the dependent claims recite additional features neither taught nor suggested by the cited art. For example, claim 30, recites a transcode subsystem that is configured to:

"wherein the transcode subsystem is further configured to automatically retrieve the transcode subunit from an external entity without receiving a user request for the transcode unit."

Regarding claim 30, on page 5 of the present Office Action, it is suggested Kaars

discloses a "transcode subsystem is further configured to automatically retrieve the transcode subunit from an external entity without receiving a user request for the transcode unit (paragraphs 23 and 28)." However, Kaars merely discloses that new transcoding algorithms may be downloaded via a data network. More specifically, Kaars discloses:

> "An alternative may be that the format of data received is determined by the receiving device (e.g., from the file extension or a header) and that the proper transcoding software is, e.g., invoked automatically later on or during the download of the data when convenient. Convenient with respect to the data processing resources available, e.g., free CPU cycles, to the receiving device." (Kaars, paragraph [0023]).

It is noted from the above that Kaars discloses automatically invoking transcoding software, but not automatically retrieving transcoding software from an external entity, as recited. Paragraph [0023] of Kaars is a general description of the process of determining the appropriate data format and corresponding transcoing software and is completely separate from the process of downloading transcoding software, as disclosed in paragraph [0028], reproduced below.

> "Next, in step 206, the system checks if the user has input, through user interface 116, an indication of a particular playback device. This can be done in the form of a numeric code. If the user has not, the system repeats step 206 until there is an input of the indication of a playback device. If the user has entered a playback device code, the process continues to step 207, where the input signal is analyzed in view of the input device to determine if the formats are compatible and thus whether transcoding is needed. If not, the processing continues at step 218 shown in FIG. 2B and described below. If transcoding is required, the process continues to step 208 wherein the processor 112 retrieves the transcoding information from memory 114. The transcoding information of various output devices is stored in memory 114. In the event a new output device is introduced into the market, the system can download via a data network, for example the Internet, new transcoding algorithms and format information." (Kaars, paragraph [0028]).

As may be seen from the above, Kaaars merely discloses that new transcoding algorithms and format information may be downloaded. Kaars provides no connection between these teachings concerning downloading transcoding software and the cited teachings concerning invoking existing transcoding software. Moreover, Kaars is silent as

to whether or not a new transcoding algorithm may be downloaded without receiving a user request for the transcode unit, as recited. In fact, the above-cited paragraph begins by discussing user inputs providing an indication of a particular playback device. In addition Kaars's Abstract explicitly teaches

> "A user can interface with the system to input information particular to the other devices and transfers. This information is stored by the system and used to determine the transcoding algorithm best suited to the needs of the user based on the user input." (Kaars, Abstract, emphasis added).

Further Kaars teaches:

> "Also included within the scope of the present invention is the ability to download from a network new or updated transcoding algorithms to enable the system to expand as the technology changes. It is also within the scope of the present invention that the apparatus itself or the user may request the proper transcoding software from a service on a network, e.g., the Internet, or the transcoding software gets downloaded from a server, together with the content information according to the specifics uploaded by the user. The server is kept up to date with regard to the equipment residing on the user's home network. For example, if the user receives content information for playback via a new piece of equipment connected to the present invention, but does not have the proper transcoding software, the software may be identified via the user having registered the new piece of equipment with the service." (Kaars [0035], lines 1-6, emphasis added).

Taken together, these teachings specify that some input or information must be provided by the user and at least suggest that a user request is required to download new transcoding algorithms and format information. Nothing in Kaars suggests that a user request is not required to download a new transcoding algorithm. Since it could be required, it is not inherent that it not be required. Accordingly, Applicant finds no teaching or suggestion in Kaars "wherein the transcode subsystem is further configured to automatically retrieve the transcode subunit from an external entity without receiving a user request for the transcode unit," as is recited in amended claim 1. For at least these additional reasons, Applicant submits claim 30 is patentably distinct from the cited art, as are claims 31 and 32 for similar reasons.

In addition, claim 8 recites

> "wherein the transcode subsystem is configured to discard the received data in response to determining the first data format is not compatible with the secondary device, and determining no transcode subunit corresponding to both the first data format and the target data format is available."

On page 7 of the present Office Action, the Examiner suggests

> "Referring to claim 8, Kaars and Croy do not disclose a client as recited in claim 1 wheiren the transcode susbsystem is configured to:
> discard the received data in response to determining the first data format is not compatible with the secondary device, and determining no transcode subunit corresponding to both the first data format and the target data format is available."

However, the Examiner further suggests Plourde teaches these features at page 14, paragraph 107, lines 22-24. The cited portion of Plourde teaches

> "the bit rate is excessive, the PVR application 377 can cause the content to bypass the TSB 378 and either be permanently recorded, or refused as a download." (Plourde, page 214, paragraph [0107], lines 22-24).

As may be appreciated from the above, Plourde refuses a download based on bit rate alone. Applicant does not concede the point of whether or not a bit-rate that is too high is equivalent to a data format that is not compatible. In addition, in contrast to the teachings of Plourde, claim 8 recites features that require two conditions to be met for the recited transcode subsystem to discard the received data. First, that the data format is not compatible and second, that no transcode subunit is available. Plourde says nothing about determining no transcode subunit corresponding to both the first data format and the target data format is available," as is recited in claim 8. Nor does Kaars in combination with Croy teach or suggest discarding the received data in response to such determinations. Consequently, the combination of Kaars, Croy, and Plourde yields a system that is capable of detecting the absence of a codec and detecting an excessive bit rate, but is only configured to block reception based on the bit rate. Nothing in the proposed combination suggests blocking reception in the absence of a codec. On the contrary, Kaars suggests if a new codec is required, one may be downloaded. Accordingly, Applicant reiterates that the cited art fails to teach or suggest that a "transcode subsystem is configured to discard the

received data in response to determining the first data format is not compatible with the secondary device, and determining no transcode subunit corresponding to both the first data format and the target data format is available," as is recited in claim 8. For at least these reasons, Applicant submits that claim 8 is patentably distinct from the cited art, taken either singly or in combination. As claims 17, 24, and 26 recite features similar to those of claim 8, claims 17, 24, and 26 are believed patentably distinct from the cited art for similar reasons.

In light of the foregoing amendments and remarks, Applicants submit that all pending claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. If a phone interview would speed allowance of any pending claims, such is requested at the Examiner's convenience.

CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5266-04300/RDR.

Respectfully submitted,

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Date: December 30, 2008